

REMARKS

The present application was filed on June 6, 2000, with claims 1-19. Claims 1-19 are currently pending in the application. Claims 1, 10 and 19 are the independent claims.

Each of claims 1-19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,146,452 (hereinafter "Pekarske") alone or in combination with another reference.

In this response, Applicant respectfully traverses the §103(a) rejections. Applicant requests reconsideration of the present application in view of the following remarks.

A proper *prima facie* case of obviousness requires that the cited references when combined must "teach or suggest all the claim limitations," and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicant submits that the Examiner has failed to establish a proper *prima facie* case of obviousness in the present §103(a) rejection of independent claims 1, 10 and 19, in that the Pekarske reference fails to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for modifying the reference teachings to reach the claimed invention.

The Examiner in formulating the §103(a) rejection of claims 1, 10 and 19 argues that the "search signature" described in column 12, lines 46-68, of Pekarske reads on the "signal associated with the demand" as recited in these claims. Applicant respectfully disagrees. The search signature of Pekarske is not described as being associated with any particular traffic demand routed between network elements, as is required by the claims. Instead, Pekarske at column 12, lines 44-47, indicates that the search signature is associated with a corresponding "channel in need of protection." It appears from column 11, lines 46-48, that the channel referred to is a "physical communication channel," such as a DS3 link. Such a channel is not properly characterized as a routed traffic demand. Thus, the Pekarske search signature cannot read on a "signal associated with the demand" as set forth in the independent claims.

Each of claims 1, 10 and 19 thus includes one or more limitations which are not taught or suggested by the Pekarske reference. This reference therefore fails to "teach or suggest all the claim limitations" as would be required by a proper §103(a) rejection.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for modifying the reference teachings to reach the claimed invention. The Examiner instead states as follows at page 2, last paragraph, of the Office Action, with emphasis supplied:

Pekarske does not explicitly disclose copy of a signal associated with the demand. However, the claim does not further define what the signal is and the traffic demand can be broadly interpret [sic] as a signal itself. Therefore, it would have been obvious to one of ordinary skill in the art to broadly interpret the replicate of search signature as the claimed copy of signal associated with the traffic demand.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present § 103(a) rejection of objective evidence of record that would motivate one skilled in the art to modify the Pekarske reference to meet the limitations in question. The above-quoted statement of obviousness given by the Examiner in the Office Action is precisely the type of subjective, conclusory statement that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. Moreover, the statement on its face fails to identify any motivation to modify Pekarske, and instead refers to motivation “to broadly interpret” a particular claim term. Applicant submits that motivation “to broadly interpret” a given claim term is entirely irrelevant in an obviousness inquiry. Such motivation “to broadly interpret” is also improperly referred to since it clearly relies upon disclosure provided by Applicant, namely, limitations of the claim itself.

Further, even if it is assumed that a proper *prima facie* case has been established, there are particular teachings in the Pekarske reference which controvert the obviousness argument put forth by the Examiner. For example, as indicated above, Pekarske specifically states that the search

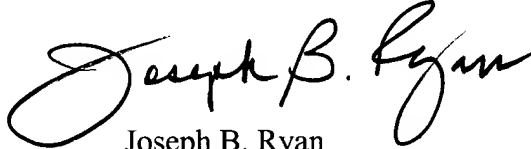
signature is associated with a corresponding "channel in need of protection," where the channel refers to a physical channel such as a DS3 link. This is a direct teaching away from the claimed invention, which calls for processing operations applied to a signal associated with a given traffic demand that is routed between network elements.

Applicant therefore respectfully submits that independent claims 1, 10 and 19 are allowable over Pekarske.

Dependent claims 2-9 and 11-18 are believed allowable for at least the reasons identified with regard to their respective independent claims, and are also believed to define separately-patentable subject matter.

In view of the above, Applicant believes that claims 1-19 are in condition for allowance, and respectfully requests withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly legible.

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Joseph B. Ryan
Attorney for Applicant(s)
Reg. No. 37,922
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7517